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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,282	01/11/2002	Chander P. Chawla	P 283276 D1144	4568
43569	7590	07/15/2005	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006				GRAY, JILL M
ART UNIT		PAPER NUMBER		
1774				

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/042,282	CHAWLA ET AL
<b>Examiner</b>	<b>Art Unit</b>	
Jill M. Gray	1774	

*- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -*

## **Office Action Summary**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 01 October 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-12 and 14-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-12 and 14-19 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-12 and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Chawla et al, 6,376,571 B1 (Chawla), for reasons of record.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

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the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Chawla is as set forth previously and teaches a cure speed of about  $0.30\text{J}/\text{cm}^2$  or less. See column 7, lines 6-19.

Accordingly, the prior art teachings of Chawla anticipate the invention as claimed in present claims 1-12 and 14-19.

Claims 1-12 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Bishop et al, US 2003/0018122 A1, (Bishop).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bishop teaches a radiation curable composition and optical fiber coated therewith, comprising a radiation curable oligomer and alkoxylated aliphatic reactive diluent wherein the composition has a cure speed of less than  $0.30\text{J}/\text{cm}^2$ , per claims 1-2, 5-9 and 15. See abstract, [0008], [0063], and Table 1. The composition comprises less than 45 wt% reactive diluent and at least 35 wt% of said radiation curable oligomer, as required by claims 3 and 4. See [0009] and [0014]. In addition, the composition can contain a silane adhesion promoter of the type contemplated by applicants in claim 11 and a photoinitiator as set forth in claim 12 (see [0069], [0065] and Table 1) and the

composition can be used an inner primary coating and have a modulus of less than 1.5 MPa, per claims 16 and 17 (see [0070] and [0072]). Regarding claim 14, since the composition of Bishop is substantially the same as applicants, the examiner has reason to believe that all properties are the same as well.

Therefore, the prior art teachings of Bishop anticipate the invention as claimed in present claims 1-12 and 14-17.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 14-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Montgomery et al, US 2002/0147248 A1 (Montgomery), for reasons of record.

Montgomery is as applied previously and teaches a radiation curable composition comprising a radiation curable oligomer and a reactive diluent essentially as claimed by applicants. Because Montgomery teaches the same composition contemplated by applicants, the examiner has reason to believe that the cure speed would be the same as well, in the absence of clear factual evidence to the contrary.

Therefore, the teachings of Montgomery anticipate, or in the alternative, render obvious the invention as claimed in present claims 1-12 and 14-19.

Claims 1-10, 12, and 14-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bishop et al, 6,714,712 B2 (Bishop) for reasons of record.

Bishop is as set forth previously and teaches a radiation curable composition and optical fiber coated therewith comprising a radiation curable oligomer, reactive diluent and photoinitiator, said composition being substantially as claimed by applicants. Because the composition of Bishop is substantially the same as that contemplated by applicants, the examiner has reason to believe that the cure speed would be the same as well, in the absence of factual evidence to the contrary.

Accordingly, the prior art teachings of Bishop would have anticipated or in the alternative, rendered obvious the invention as claimed in present claims 1-10, 12, and 14-19.

Claim 11 is rejected under 35 U.S.C. 103(a) as being obvious over Bishop et al, 6,714,712 B2 (Bishop) in view of Chawla et al, 6,376,571 B1 (Chawla), for reasons of record.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed

in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-23 of copending Application No. 10/042,284. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the alkoxyated aliphatic reactive diluent of the present claims is a monofunctional reactive diluent absent an aromatic ring.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments filed October 1, 2004 have been fully considered but they are not persuasive.

Applicants argue that none of Chawla, Montgomery, or Bishop alone or in combination disclose or render obvious a radiation curable optical fiber coating composition including a radiation curable oligomer and an alkoxyated aliphatic reactive diluent comprising an aliphatic moiety having at least 7 carbon atoms, where the coating composition has a cure speed of less than 0.30J/cm<sup>2</sup>

In this regard, each of the prior art references teach radiation curable optical fiber coatings, and optical fiber coated therewith, said coatings being substantially of the type contemplated by applicants, and comprising a radiation curable oligomer and an alkoxyated aliphatic reactive diluent, further teaching that this diluent can be isodecyl acrylate. As set forth previously, each of the prior art compositions are substantially the same as that claimed by applicants. The same composition necessarily has the same properties. Accordingly, where not specifically stated in the prior art, the examiner has

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reason to believe that the cure speed of the prior art composition is the same as that of applicants, in the absence of clear factual evidence to the contrary.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jill M. Gray  
Examiner  
Art Unit 1774

jmg